

## REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on July 15, 2003, the Examiner made objections under 35 U.S.C. §132 and 35 U.S.C. §112, first paragraph, rejected claims 21-29 and 31-41 under 35 U.S.C. §112, first paragraph, rejected claims 21-29 and 32-41 under 35 U.S.C. §103(a) as being unpatentable over Evans (U.S. Patent No. 5,924,074, hereinafter "Evans") in view of Feldon et al (U.S. Patent No. 5,732,221, hereinafter "Feldon").

Applicant respectfully submits that the amendments provided herein are responsive to the request made by the Examiner in the Office Action to "provide claim language which reflects the terminology found within the specification." (See page 3) Accordingly, Applicant respectfully submits that the amendments provided herein are not narrowing in nature. Instead, the amendments further clarify distinguishing limitations of the present invention as claimed over the cited prior art.

Regarding the objections and rejections made by the Examiner in the Office Action, the Applicant respectfully provides the following:

### 35 U.S.C. § 132

Applicant respectfully submits that the term "dynamically" has been cancelled. Accordingly, Applicant respectfully submits that the amendments provided herein overcome the objection made by the Examiner under 35 U.S.C. §132.

### 35 U.S.C. § 112

Applicant respectfully submits that the term "dynamically" has been cancelled. Accordingly, Applicant respectfully submits that the amendments provided herein overcome the objection made by the Examiner to the specification under 35 U.S.C. §112, first paragraph, and

overcome the rejections made by the Examiner to claims 21-29 and 31-41 under 35 U.S.C. §112, first paragraph.

35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 21-29 and 32-41 under 35 U.S.C. §103(a) as being unpatentable over Evans in view of Feldon. Applicant respectfully submits that the claim set as provided herein is not made obvious by the cited references.

The standard for a Section 103 rejection is set for in M.P.E.P 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

Applicant respectfully submits that the references cited by the Examiner do not teach or suggest the limitations claimed in the present invention. Evans teaches of a medical records system that creates and maintains all patient data electronically. The system captures patient data, such as patient complaints, lab orders, medications, diagnoses, and procedures, at its source at the time of entry using a graphical user interface having touch screens. Using pen-based portable computers with wireless connections to a computer network, authorized healthcare providers can access, analyze, update and electronically annotate patient data even while other providers are using the same patient record. The system likewise permits instant, sophisticated analysis of patient data to identify relationships among the data considered. Moreover, the system includes the capability to access reference databases for consultation regarding allergies,

medication interactions and practice guidelines. The system also includes the capability to incorporate legacy data, such as paper files and mainframe data, for a patient. (Abstract)

Feldon teaches of a system and method for generating written reports based on succinct input from a user. A method comprises entering a first mode for initialization; defining menus; entering a second mode for receiving information; entering information using the defined menus; interpreting the entered information; and generating a written report in response to the interpreting step. A system comprises a portable computer system having a memory, a processor, a detachable keyboard, a screen, and a pen. Ancillary information is entered with the keyboard which is then detached. Subsequent information is documented by selecting appropriate items from the defined menus; alternatively, the information can be written on the screen with the pen. The processor is programmed to interpret the inputs and generate a report. The report may be printed on a printer, stored on a storage device, and/or transferred to another system. (Abstract)

In contrast, the independent claims of the present invention include limitations directed to generation of a customizable form based on electronically selecting a pool of healthcare procedures characteristically performed by a particular healthcare provider of a healthcare facility for inclusion in the customizable form, wherein the pool of healthcare procedures reflect the medical services rendered by the particular healthcare provider. Such limitations are supported by the disclosure as originally filed. For example, page 11 of the application as filed, beginning on line 5, provides: "The provider records further define how a provider works under different situations. For instance, a provider seeing a new patient, or a provider performing surgery, would perform different procedures, and therefore, have a different selection on the visit

form. The visit form definition records define a pool of formats that can be selected by a provider to meet these individual needs.”

As mentioned by the Examiner in the Office Action, “Evans fails to expressly disclose generating a dynamically customizable form, including selecting procedures and diagnoses for inclusion in the form.” (See page 8)

Further, while Feldon teaches that “since a system (100) can be programmed according to the user’s needs, it may be customized for the particular task at hand,” (col. 4, lines 52-54) Feldon is silent in any teaching of generating a customizable form based on electronically selecting a pool of healthcare procedures characteristically performed by a particular healthcare provider of a healthcare facility for inclusion in the customizable form, wherein the pool of healthcare procedures reflect the medical services rendered by the particular healthcare provider.

Applicant respectfully submits that for at least the reasons provided herein, the references cited by the Examiner, alone or in combination, do not teach or suggest all the claim limitations. And, since the references cited by the Examiner do not teach or suggest each and every limitation of the independent claims, Applicant respectfully submits that the prior art references do not make obvious the claim set as provided herein.

Thus, Applicant respectfully submits that for at least the reasons provided herein, the claim set overcomes all objections and rejections made by the Examiner in the Office Action.

CONCLUSION

Applicants submit that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicants request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

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Respectfully submitted,



Bernie S. Broadbent  
Attorney for Applicant  
Registration No. 30,550

KIRTON & McCONKIE  
1800 Eagle Gate Tower  
60 East South Temple  
Salt Lake City, Utah 84111  
Telephone: (801) 321-4802  
Facsimile: (801) 321-4893

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